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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/785,672	02/23/2004	Michael P. Whitman	11443/160	2683
26646 7590 09/11/2009 KENYON & KENYON LLP ONE BROADWAY NEW YORK, NY 10004				
EXAMINER				
WEEKS, GLORIA R				
ART UNIT		PAPER NUMBER		
3721				
MAIL DATE		DELIVERY MODE		
09/11/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/785,672

Applicant(s)

WHITMAN ET AL.

Examiner

GLORIA R. WEEKS

Art Unit

3721

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 June 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 100-109 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 100-109 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is in response to the remarks received on June 2, 2009.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 100-104 and 106-109 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grant et al. (USPN 5,609,285) in view of Toledano (USPN 5,855,312).

In reference to claims 100-104 and 106-109, Grant et al. discloses a surgical device, comprising: a staple housing 114 defining a bore 104; a trocar shaft 206 disposed through the bore 104 of the housing 114 and extends distally¹ relative to a clamping face (figures 6-7), so as to be moveable relative to the housing 114 by operation of at least one driver 84 by a first rotatable drive shaft 96, wherein the at least one driver 84 is within the housing 114; and an anvil 100 attachable to the trocar shaft 206 and configured to be moveable relative to the housing by movement of the trocar shaft, wherein the anvil 100 includes an anvil shaft 110 and an anvil sleeve 105, the anvil shaft 110 defining a trocar receiving slot 103 (figure 10) and the anvil sleeve 105 having a recess 134 (figures 15-16) receiving a rim 132 that protrudes 168 radially inwardly from the bore 104; and a second driver 85 operable a second rotatable drive shaft 92 to

¹ **dis-tal** (d's"t...l) *adj.* 1. Anatomically located far from a point of reference, such as an origin or a point of attachment. (American Heritage Dictionary)

drive staples from the staple housing 114.. Grant et al. does not disclose the trocar shaft to include a flexible portion.

Figure 1 and column 3 line 65- column 6 line 59 of Toledano teaches a surgical device, comprising: a staple housing defining a bore; a trocar shaft disposed through the bore of the housing and extends distally² relative to a clamping face, so as to be moveable relative to the housing by operation of at least one driver within the housing; and an anvil attachable to the trocar shaft and configured to be moveable relative to the housing by movement of the trocar shaft, wherein the anvil includes an anvil shaft 140, the anvil shaft defining a trocar receiving slot, and the trocar shaft including a flexible trocar 22 configured to be insertable within the trocar receiving slot and the trocar receiving slot is defined in an anvil sleeve 16 having an axially-extending bore in communication with the trocar receiving slot, wherein the axially-extending bore has a wide portion into which the flexible trocar is insertable and a narrow portion which retains the trocar 22 within the axially-extending bore. It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the trocar shaft of Grant et al. to include a flexible portion, since column 4 lines 4-17 of Toledano states that such a modification improves the surgical conditions of closed surgery by enabling accurate alignment of a staple housing and anvil.

4. Claim 105 is rejected under 35 U.S.C. 103(a) as being obvious over Grant et al. (USPN 5,609,285) in view of Toledano (USPN 5,855,312) as applied to claim 108 above, and further in view of Whitman (USPN 6,491,201).

² **dis-tal** (d's"t...l) *adj.* 1. Anatomically located far from a point of reference, such as an origin or a point of attachment. (American Heritage Dictionary)

Regarding claim 105, the modified apparatus of Grant et al. discloses a surgical instrument having a first driver and a second driver, each respectively manually actuated via a first and second drive shaft; but Grant et al. does not disclose controlling rotation of each driver with a motor. Whitman teaches a surgical instrument having a flexible shaft (215) movable relative to a housing (155) by way of a rotatable driver (170) selectively rotated by at least one motor (165) via a controller (160). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the surgical instrument of Toledano include the motor rotatable driver of Whitman, as column 3 lines 17-31 of Whitman states that such a modification allows an operator to selectively and automatically control rotation of the driver.

Furthermore, It has been held that broadly providing a mechanical or automatic means to replace manual activity which has accomplished the same result involves only routine skill in the art.³

Response to Arguments

5. Applicant's arguments with respect to claims 100-109 have been considered but are moot in view of the new ground(s) of rejection.

³ *In re Venner*, 120 USPQ 199.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Refer to attachment for notice of references cited and recommended for consideration based on their disclosure of limitations related to the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GLORIA R. WEEKS whose telephone number is (571)272-4473. The examiner can normally be reached on M-F 7am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi I. Rada can be reached on (571) 272-4467. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Other helpful telephone numbers are listed for applicant's benefit:

- Allowed Files & Publication (888) 786-0101
- Assignment Branch (800) 972-6382
- Certificates of Correction (703) 305-8309
- Fee Questions (571) 272-6400
- Inventor Assistance Center (800) PTO-9199
- Petitions/special Programs (571) 272-3282
- Information Help line 1-800-786-9199

/Gloria R. Weeks/
Examiner, Art Unit 3721

/Rinaldi I Rada/
Supervisory Patent Examiner, Art Unit
3721

September 10, 2009